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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,337	02/23/2004	Tracee Eidenschink	S63.2-11319	8721
490	7590	01/11/2006	EXAMINER	
VIDAS, ARRETT & STEINKRAUS, P.A. 6109 BLUE CIRCLE DRIVE SUITE 2000 MINNETONKA, MN 55343-9185			COZART, JERMIE E	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,337

Applicant(s)

EIDENSCHINK ET AL.

Examiner

Jermie Cozart

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 37 and 38 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-33, 35 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4, 7, 8, 9/04, & 6/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Orain (3,792,603).

Orain discloses a system comprising a contracting assembly, the contracting assembly comprising a plurality of moveable contracting members (3, 4, 5), each of the contracting members (4, 5) having a predetermined shape, at least one of the contracting members (3) having a different predetermined shape than the predetermined shape of each of the other contracting members, the plurality of contracting members defining a cross-sectional surface area reduction chamber (fig. 5, 6), the chamber having a reduced cross-sectional surface area configuration and a pre-reduction cross-sectional surface area configuration. The predetermined shape of the contracting members (3, 4, 5) is substantially rectangular. The system has a stent assembly engagement surface (i.e. recess area, not labeled fig. 5) of the at least one of the contracting members (3, 4, 5) defines a stair-step area. See column 3, lines 42-54, and figures 5-6 for further clarification.

Note that the recitation “for reducing the cross-sectional surface area of a stent assembly” has not been given patentable weight because the recitation occurs in the

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preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Note that "the contracting assembly constructed and arranged to receive at least a portion of a stent assembly into the chamber, wherein when the chamber is in the pre-reduction cross-sectional surface area configuration the at least a portion of the stent assembly has a first cross-sectional surface area and when the chamber is in the reduced cross-sectional surface area configuration the at least a portion of the stent assembly has a second cross-sectional surface area, the second cross-sectional surface area being less than the first cross-sectional surface area" is a recitation of the intended use, and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kralowetz (4,461,163).

Kralowetz discloses a system comprising a contracting assembly, the contracting assembly comprising a plurality of moveable contracting members (4), each of the contracting members (4) having a predetermined shape, at least one of the contracting

members (4, fig. 1) having a different predetermined shape than the predetermined shape of each of the other contracting members, the plurality of contracting members (4) defining a cross-sectional surface area reduction chamber (not labeled, fig. 1), the chamber having a reduced cross-sectional surface area configuration and a pre-reduction cross-sectional surface area configuration. See column 2, lines 17-51, and figure 1 for further clarification.

Note that the recitation “for reducing the cross-sectional surface area of a stent assembly” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Note that “the contracting assembly constructed and arranged to receive at least a portion of a stent assembly into the chamber, wherein when the chamber is in the pre-reduction cross-sectional surface area configuration the at least a portion of the stent assembly has a first cross-sectional surface area and when the chamber is in the reduced cross-sectional surface area configuration the at least a portion of the stent assembly has a second cross-sectional surface area, the second cross-sectional surface area being less than the first cross-sectional surface area” is a recitation of the intended use, and a recitation of the intended use of the claimed invention must result in

a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Allowable Subject Matter

4. Claims 4-33, 35, and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
5. Claim 34 is allowed.
6. The following is a statement of reasons for the indication of allowable subject matter: Regarding **claim 34**, the prior art does not teach or suggest a first mandrel, a portion of the first mandrel constructed and arranged to be positioned within the diameter reduction chamber, a first portion of the stent assembly disposed about the portion of the first mandrel; and a protective sheath, the protective sheath constructed and arranged to be positioned within the diameter reduction chamber, the protective sheath disposed about the stent assembly, the protective sheath having a wall thickness and an inside surface, the inside surface being defined by a wall thickness pattern, the wall thickness pattern comprising alternating thicker portions of the wall thickness and thinner portions of the wall thickness, the thicker portions extending radially inward toward the stent assembly to a greater extent than the thinner portions, a thinner portion being positioned between each thicker portion, in combination with the other claimed limitations.


Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited on the attached PTO-892 are cited to show crimping devices with contracting members.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermie Cozart whose telephone number is 571-272-4528. The examiner can normally be reached on Monday-Thursday, 7:30 am - 6:00 pm.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Jimenez can be reached on 571-272-4530. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jermie Cozart
Examiner
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